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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,815	05/24/2001	Tetsuo Takakura	4554-002	8903

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EXAMINER

BOVEJA, NAMRATA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/863,815	Applicant(s) TAKAKURA ET AL.	
	Examiner Namrata Boveja	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/863,815.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/26/05, 5/24/01, 6/18/03, 2/6/03, 8/20/02, 4/21/02, 6/</u> | <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-22 are presented for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 20-22 are rejected under 35 U.S.C. 101, because the claimed invention is directed to a non-statutory subject matter.

The claimed invention taken as a whole is directed to a mere computer program (a program listing), i.e., to only its description or expression. The claim is descriptive material per se and hence non-statutory. A computer program is merely a set of instructions capable of being executed by a computer; the computer program itself is not a process. A claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, is non-statutory functional descriptive material. See MPEP § 2106 IV. B. 1. (a).

Claim Rejections - 35 USC § 112

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention. There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

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3. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 teaches parameter data that "specifies the operation of tracking data for use in animations stored in each of said client devices." It is unclear what is meant by parameter data in this claim. It is interpreted to mean control information added by said transmission data generation unit is parameter data such as demographic parameters. Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 10-14, 16, 17, 19, 20 and 22 are rejected under 102(e) as being anticipated by Virine et al (Patent Number 6,604,138 hereinafter Virine).

In reference to claims 1, 14, 17, and 20, Virine teaches an advertising system, method, a computer-readable recording medium, and a computer program comprising at least one server device and at least one client device connected to said server device (col. 4 lines 10-19, col. 8 lines 32-44, and Figure 3B), and advertising data is transmitted from said server device to said client

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device (col. 5 lines 17-31, and col. 8 lines 39-44), wherein said server device includes, a user information storage which stores information related to users of the respective client devices (col. 7 lines 36-40 and 58-63 and col. 9 lines 16-24); an advertising information storage which stores plurality advertising data that have different advertising contents (col. 9 lines 28-32, col. 10 lines 1-4, col. 14 lines 39 to col. 16 lines 37, and Figures 7A-7C); an advertisement selection unit which, based upon the information stored in said user information storage, selects advertising data to be transmitted to said client devices from a plurality advertising data stored in said advertising information storage (col. 14 lines 34 to col. 16 lines 37 and Figures 7A-7C); and a transmission data generation unit which generates advertisement transmission data so as to transmit the advertising data selected by aid advertisement selection unit to said client devices (col. 14 lines 12-33, col. 16 lines 16-37, and Figures 7A-7C).

5. In reference to claim 2, Virine teaches the advertising system wherein the information stored in said user information is information related to attributes of respective users (col. 9 lines 58-61 and col. 11 lines 22 to col. 12 lines 36); and aid advertisement selection unit selects advertising data in accordance with the attributes of each of the users (col. 9 lines 50-65, col. 14 lines 57 to col. 16 lines 37, and Figures 7A-7C).

6. In reference to claim 3, Virine teaches the advertising system wherein the information stored said information storage is information related to history of the information that has been viewed by each of the users; and aid advertisement selection unit selects advertising data in accordance with the information that has

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been viewed by each of the users (col. 7 lines 36-40 and lines 58-63, col. 10 lines 26-37 and lines 64 to col. 11 lines 27, col. 14 lines 39-56, and Figure 5).

7. In reference to claim 4, Virine teaches the advertising system wherein inter-advertisement-related information which indicates the correlation between a plurality of advertising data is stored in said advertising information storage; and said advertisement selection unit selects advertising data based upon information stored in said user information storage and finally selects advertising data that has a predetermined advertising data based upon the advertising data and inter-advertisement-related information stored said inter-advertisement relationship with advertising information storage (col. 14 lines 9-11 and col. 15 lines 59 to col. 16 lines 37).

8. In reference to claims 10, 16, 19, and 22, Virine teaches an advertising system, method, computer-readable medium, and a computer program comprising at least one server and least one client device connected to said server device (col. 4 lines 10-19, col. 8 lines 32-44, and Figure 3B), wherein said server device includes, an advertising information storage which stores a plurality of advertising data that have mutually different data formats (col. 5 lines 23 to col. 7 lines 35 and Figures 2A-2C); an advertisement selection unit which selects advertising data to be transmitted to said client devices from plurality advertising data stored said advertising information storage (col. 14 lines 34 to col. 16 lines 37 and Figures 7A-7C); and a transmission data generation unit which generates advertisement transmission data so as transmit advertising data selected by said advertisement selection unit to said client devices (col. 14 lines 12-33, col. 16

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lines 16-37, and Figures 7A-7C), wherein, said transmission data generation unit being allowed to add control information for controlling the output format of the advertising data in said client devices to the advertisement transmission data (i.e. where the video was left off last time by a user, the number of times an advertisement should be played, what time of day an advertisement should be played, and the sequence of advertisements) (col. 6 lines 1-19, col. 7 lines 10-35, col. 9 lines 32 to col. 10 lines 25, col. 13 lines 56-65, col. 14 lines 42-56, and Figure 2B).

9. In reference to claims 11 and 12, Virine teaches the advertising system wherein the control information added by said transmission data generation unit is information related to timing (i.e. number of times an ad is displayed and at what time is the ad displayed) in which the advertising data is outputted by said client devices (col. 6 lines 10-20, col. 7 lines 25-34, col. 9 lines 34-36, col. 10 lines 1-24, col. 13 lines 56-65, and col. 14 lines 39-56) and the number of times in which the advertising data is outputted by each of the client devices (col. 13 lines 56-65, and col. 14 lines 39-56).

10. **Disclaimer:** Parameter is interpreted to mean demographic parameters from above, since this claim was unclear as explained earlier.

In reference to claim 13, Virine teaches the advertising system wherein control information added by said transmission data generation parameter data (i.e. demographic parameters) (col. 12 lines 21-36 and col. 14 lines 1-11) that specifies the operation of tracking data (i.e. user history data) for use in animations stored in each of said client devices.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5-9, 15, 18, 21 are rejected under 103(a) as being anticipated by Virine in view of Aharoni et al (Patent Number 6,014,694 hereinafter Aharoni).

In reference to claims 5, 15, 18, and 21, Virine teaches an advertising system, method, a computer-readable recording medium, and a computer program comprising at least one server device and at least one client device connected to said server device (col. 4 lines 10-19, col. 8 lines 32-44, and Figure 3B), and advertising data is transmitted from said server device said client device (col. 5 lines 17-31, and col. 8 lines 39-44), an advertising information storage which stores a plurality of advertising data that have mutually different data formats (col. 5 lines 23 to col. 7 lines 35 and Figures 2A-2C); and a transmission data generation unit which, based upon the communication speed detected by the communication speed detection unit, selects advertising data having corresponding data format, and generates advertisement transmission data for transmitting this advertising data to said client device (col. 14 lines 12-33, col. 16 lines 16-37, and Figures 7A-7C).

Virine does not teach wherein said server device includes, a communication speed detection unit which detects the communication speed

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between said server and each of said unit devices; and a transmission data generation unit which, based upon the communication speed detected by the communication speed detection unit, selects advertising data for transmittal to said client device.

Aharoni teaches wherein said server device includes, a communication speed detection unit which detects the communication speed between said server and each of said unit devices (col. 11 lines 26-65, col. 13 lines 10-36, and Figure 15); and a transmission data generation unit which, based upon the communication speed detected by the communication speed detection unit, selects advertising data for transmittal to said client device (col. 10 lines 22-49, col. 11 lines 26-65, and col. 18) depending on the available bandwidth for the client where any video or audio data can be taken to be "advertisement" video or audio. The video and audio file is taken to be an advertisement for its content. Any video, video scenes, or audio files, can be used as advertisements. There is no particular requirement set forth that defines advertising video or audio from other video or audio. Furthermore, Aharoni acknowledges video advertising on the Internet (col. 1 lines 11-15).

It would have been obvious to modify Virine to include a communication detection unit and a transmission data generation unit that selects advertising data for transmittal based on the communication speed to help users receive appropriate content that will not slow down the receiving system as a result of sending large sized files say on a dial-up connection (i.e. low bandwidth

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connection) and to therefore help the user's system from crashing due to information overload and will therefore help the user's system from crashing.

12. In reference to claim 6, Virine teaches the advertising system wherein image data and sound data are stored in said advertising information storage as the advertising data; and said transmission data generation unit generates the advertisement transmission data by selecting both of the image data and the sound data or either of these (col. 2 lines 26-32, col. 3 lines 61 to col. 4 lines 6, col. 5 lines 23-31, col. 6 lines 55 to col. 34, col. 9 lines 50 to col. 10 lines 24).

Virine does not a transmission data generation unit generating the advertisement transmission data based upon the communication speed detected by the communication speed detection unit. Aharoni teaches a transmission data generation unit generating transmission data based upon the communication speed detected by the communication speed detection unit (col. 10 lines 22-49 and col. 18) depending on the available bandwidth for the client where any video or audio data can be taken to be "advertisement" video or audio. The video and audio file is taken to be an advertisement for its content. Any video, video scenes, or audio files, can be used as advertisements. There is no particular requirement set forth that defines advertising video or audio from other video or audio. Furthermore, Aharoni acknowledges video advertising on the Internet (col. 1 lines 11-15), and he mentions a server that identifies a user's measured connection speed and determines a particular file set (compression level) based on such speed. The rate controller chooses the particular file set to send. .

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It would have been obvious to modify Virine to include a transmission data generation unit generating the advertisement transmission data based upon the communication speed detected by the communication speed detection unit to help users receive appropriate audio, video, both, or either type of content that without slowing down the receiving system as a result of sending large sized files say on a dial-up connection (i.e. low bandwidth connection) and to therefore help the user's system from crashing due to information overload.

13. In reference to claims 7, 8, and 9, Virine does not teach the advertising system wherein a plurality of advertising data having mutually different output times are stored in said advertising information storage; and said transmission data generation unit generates the advertisement transmission data by selecting advertisements having any one of output times (i.e. how long it takes for the user to receive the output based on file type and size), transmission data in either a non-compressed or compressed manner, and advertising data in either non-divided manner or a divided manner from said advertising information storage based upon the communication speed detected the communication speed detection unit.

Aharoni teaches the advertising system wherein a plurality of advertising data having mutually different output times (i.e. larger files are associated with a greater output time, since it takes longer to send those files to the user) are stored in said advertising information storage. It is inherent in the system of Aharoni that a mapping between required compression level and location of files satisfying such bandwidth characteristics exist in some manner of the datastore

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(i.e. a database determining which file sets are to be used for various bandwidth situations); and said transmission data generation unit generates the advertisement transmission data by selecting advertisements having any one of output times (i.e. how long it takes for the user to receive the output based on file type and size), transmission data in either a non-compressed or compressed manner, and advertising data in either non-divided manner or a divided manner from said advertising information storage based upon the communication speed detected the communication speed detection unit. Aharoni teaches compression of video file into sever (N) sets of files having different compression rates (i.e. N can be zero if the video doesn't need to be compressed) (col. 18). Aharoni's server identifies a user's measured connection speed and determines a particular file set (compression level) based on such speed. The rate controller chooses the particular file set to send.

It would have been obvious for Virine to have included advertising data with different output times, compression categories, and division categories based upon the communication speed to help categorize and select which files should be sent to users with different types and speeds of connection and to determine how much compression is needed based on available bandwidth.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

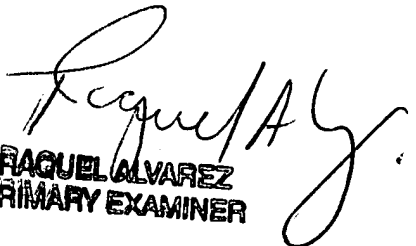
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8105. On July 15, 2005, the Central FAX Number will change to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

August 5, 2005


RAQUEL ALVAREZ
PRIMARY EXAMINER